

Appl. No. 10/023,245
Reply Under 37 C.F.R. § 1.111 dated August 9, 2006
Reply to Office Action mailed May 15, 2006

REMARKS/ARGUMENTS

Claims 1 - 24 are pending in the application for consideration.

Claims 25 - 30, which were withdrawn from consideration as being drawn to a non-elected invention pursuant to a requirement for restriction, have been canceled previously during prosecution.

1. The Office Action contains a new ground of rejection in response to the Appeal Brief filed by applicants. Accordingly, applicants have been provided with a choice of exercising one of two options, i.e., reopen prosecution or maintain the appeal.

Applicants hereby elect to reopen prosecution in the application.

2. Claims 1 - 10, 13 - 18 and 21 - 24 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over United States Patent Application Publication No. US 2002/0078160 A1 ("Kemp et al.") in view of United States Patent Application Publication No. US 2002/0113994 A1 ("Smith, II et al.").

Applicants traverse this ground of rejection. The references do not teach or suggest the subject matter of the claims within the meaning of Section 103. Applicants' claims are directed to situations where a user contacts a service provider, such as an airline, digital photo processor, rebate coupon service, etc., via a mobile computing and/or communication device (which does not include an attached or integrated printer) to initiate and complete a service transaction with a remote service

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provider and would like to obtain a permanent record of the transaction at a remote printer chosen and designated by the user. This provides the user with a much more convenient alternative to doing these types of transactions at a fixed location computer that has an attached or integrated local printer.

To carry out the purpose of having the remote service provider deliver the input data for the permanent record to the user chosen and designated remote printer, as set forth in the claims, the user must provide the service provider with the data necessary to provide the service including user provided data identifying and specifying the user chosen remote printer and data regarding how to address and access the remote printer over a data communications network.

Thus, when using the methods and systems embodying the present invention, it is the user who is allowed to select a convenient location of the printer to which the permanent record will be printed rather than having the service provider printing it on a remote printer of its choosing and designation after which the printed record would have to be shipped or delivered to the user.

The Office Action acknowledges that Kemp et al. "does not explicitly show [a] user chosen and designated specific remote printer." In order to show this limitation the Office action relies on Smith II et al. Even assuming *arguendo* that the references can be properly combined in this manner, neither of the cited references teaches or suggests a limitation recited in the claims, namely, "said data necessary to provide the service being processed to generate data required for the

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service." (see the last two lines of Step (A) of claim 1). Although the Office Action points generally to paragraphs [0035] - [0042] of Kemp et al. for a disclosure of this limitation, these paragraphs of the reference merely describe general features of the system of Kemp et al. such as the fact that it includes a service provider 2 which may process print jobs on behalf of a home user 1.

Applicants' claims recite a distinction between the "data necessary to provide the service" and the "data required for the service." According to the claimed method of applicants the "data necessary to provide the service" (Fig. 5A, element 120) are provided by the user through the communication device 10 to the receiving center 12 (Fig. 5A, element 100). For example, if the service is the purchase of a ticket for a movie or other event, the "data necessary to provide the service" may include the name and date of the event and the user's credit card number (see page 9 of the application).

The server 40 then processes (Fig. 5A, step 110) the request for service and the data necessary to provide the service (Fig. 5A, element 120) thereby generating the data required for the service (Fig. 5A, element 165). In other words, the server 40 generates the "data required for the service" by processing the "data necessary to provide the service" (see page 9 of the application).

The application teaches, in the paragraph bridging pages 9 and 10, the distinction between the "data necessary to provide the service" and the "data required for the service". In the example described in that paragraph the user provides the "data necessary to

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provide the service" (the "to" and "from" addresses on the user's travel route) and the server processes this data to generate the "data required for the service", namely travel directions from the "from" address to the "to" address, an image of a map showing the travel route and an estimate of travel time.

In step (B) of claim 1, the "data required for the service" are then "process[ed] to generate input data for a specific and identified user chosen and designated remote printer." In other words, claim 1 defines two processing steps involving these two different kinds of data, namely

- (1) in step (A), processing the "data necessary to generate the "data required for the service" and
- (2) "processing...said data required for the service...to generate input data for a...printer."

In contrast, Kemp et al. only discloses a single processing step. As described generally in paragraphs [0036] - [0042], according to the system of the reference the user submits a print request to the service provider in response to which the service provider generates print data for the printer. There is no additional step of processing the data initially generated by the server to generate input for the printer.

Smith II et al. has been relied upon for the teaching of a user designated specific remote printer. This reference does not teach or suggest two processing steps involving two different types of data as is practiced according to the invention of applicants.

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Claim 15 is drawn to a system for providing the service and recites means for carrying out the process steps discussed above.

Reconsideration of this ground of rejection and, for the reasons discussed, withdrawal thereof are respectfully requested.

3. Claims 11, 12, 19 and 20 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Kemp et al. in view of United States Patent Application Publication No. US 2002/0100802 A1 ("Sehr") and further in view of Smith II et al.

Claims 11 and 12 are dependent on claim 1 and recite the method wherein the requested service is an event ticket or a coupon, respectively. Claims 19 and 20 are dependent on claim 15 and recite the system wherein the requested service is an event ticket or a coupon, respectively.

These claims are patentably distinguishable over the references for the same reasons set forth above with respect to Kemp et al. and Smith II et al. and further because Sehr does not teach or suggest the claimed subject matter. Sehr has been cited only for the teaching that a requested service is an event ticket. However, Sehr does not teach or suggest two processing steps involving two different types of data as is practiced according to the invention of applicants.


Reconsideration of this ground of rejection and withdrawal thereof are respectfully requested.

In summary, claims 1 - 24 are proper in form for allowance and in substance have been shown to be wholly novel and patentable over the references of record.

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Reconsideration of the application and allowance of these
claims are respectfully requested.

Respectfully submitted,



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